

## REMARKS

Within the present application Claims 1- 3, 7-11, 13-16, and 19-23 are currently pending.

### REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1 and 16 are the only independent claims remaining in the present application. Thus, by operation of law claims which depend from claims 1 and 16 are patentable if claims 1 and 16 are held to be patentable. Thus, only the objection raised by the combination of *Acker* and *Hills* will be addressed.

#### Rejection under 35 U.S.C. 103(a) *Acker* in further view of *Hills*

Within the present Official Action claims 1-3, 7, and 16 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Acker* (US 5,066,259) in further view of U.S. Patent Number 4,170,086 to *Hills*. The PTO states that *Acker* does not specifically disclose a doll structure wherein the core is made from a foamed polymeric material. However, the PTO states that *Hills* teaches a stuffed toy animal wherein the stuffing material can be made from a PCV foam, mat or natural or synthetic fiber. The PVC foam has been held by the PTO to be an equivalent material to a fiber mat to add the weight and bulk to a toy. Thus, the PTO contends that it would have been obvious to one of ordinary skill in the art to substitute PVC foam for the fiber mat of *Acker* since the two materials give weight and bulk to a toy.

For a reference to relied upon under 35 U.S.C. § 103(a) it must be analogous art. MPEP 2141.10(a). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably

pertinent to the particular problem with which the inventor was concerned." MPEP 2141.01(a) citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

In response to Applicant's argument that the cited art of *Hills* and *Acker* is non-analogous the PTO states on page 6, paragraph 6 the following:

Applicant argues that since both cited referenced are non-analogous, the can not be combined to render obvious the present invention. The examiner respectfully wishes to point out that Asker and Hill are both non-analogous to the claimed invention; therefore; MPEP 2141.10 (a) does not apply.

Thus, Applicant assumes the PTO is arguing that so long as the combined art is analogous to each other it does not matter that the combined art is not analogous to claimed invention. Is Applicant to understand that it is the PTO's position, as stated in the Official Action, that the combined art does not need to be analogous to the claimed invention, but only be analogous to each other. If so, there has been a great misunderstanding of the law. Applicant respectfully states again, by operation of law, the claims should be allowable since the cited art, as agreed to by the PTO, is non-analogous.

The PTO further states that it is unnecessary for *Hills* to be reasonably pertinent to the particular problem with which the applicant was concerned as required by MPEP 2141.01 because *Asker* and *Hills* are analogous to each other. Applicant notes the PTO contends that the cited art is not in Applicant's field of endeavor and is not reasonably pertinent to the particular problem with which the inventor was concerned.

Applicant notes *Hills* and *Asker* are relied upon by the PTO under 35 U.S.C. 103 in an obvious rejection of the present application. The PTO contends that MPEP 2141.01(a) does not

apply because *Hills* and *Asker* are analogous to each other but not to the claimed invention. Art must be analogous to Applicant's claimed invention and not just analogous to each other. If the cited art is not analogous to the claimed invention and is not pertinent to the problem solved by the invention then one of ordinary skill in the art would have no motivation to combine art to render the claimed invention obvious. The cited prior art is required to have some analogy to the claimed invention and not just to itself.

Applicant respectfully contends that the PTO cannot ignore MPEP 2141.01(a) and the case law behind it simply by stating that the combined art is analogous to each other even though neither is analogous to the claimed invention.

Applicant suggests the PTO revisit the reasoning behind the MPEP 2141.01(a) and the case law behind the section. Why would the court require an examiner to apply only analogous art in a rejection of the claimed invention under 35 U.S.C. 103(a)? Is the requirement to analogous art directed to the art being analogous to the claimed invention or the cited art being only analogous to each other? Applicant respectfully contends the law is clear; the cited art must be analogous to the claimed invention.

Applicant respectfully asserts that for the PTO to state the law of analogous prior art as noted in MPEP 2141.01(a) does not apply if the prior art is analogous to each other is in Applicant' opinion a grave misstatement of the law. As stated in the Official Action, the cited art of *Asker* and *Hills* are both non-analogous and not reasonably pertinent to the particular problem with which the applicant is concerned. Since this is the case, why would one of ordinary skill in the art have combined the cited references to render obvious the claimed invention.

The PTO apparently contends that if both of the combined cited references are non-analogous, but are analogous to each other then MPEP 2141.10 (a) does not apply. It would

further appear the PTO is contending that MPEP 2141.10 (a) only applies if one reference is analogous and the other is not. Thus, according to the PTO in the present action since both of the cited references are non-analogous MPEP 2141.10 (a) does not apply. Applicant respectfully disagrees. The non-analogous test is not negated because both references happen to be non-analogous. Just the opposite is true, if both references are non-analogous then they cannot be combined to render obvious the present invention.

The PTO further contends in the present action that "non-analogy between the prior art references and the claimed invention are completely irrelevant to the issues of obviousness." Applicant respectfully disagrees with this statement since it is clear from both the MPEP and current case law that the reverse is true. Applicant further draws the PTO's attention to MPEP 707.07 which states in part:

In response to applicant's argument that [1] is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, [2].

Analogy is very relevant to the determination of obviousness. Federal Circuit recently stated in *In re Kahn* (Fed Cr. 2006, 04-1616):

Although our predecessor court was the first to articulate the motivation-suggestion-teaching test, a related test—the "analogous art" test—has long been part of the primary Graham analysis articulated by the Supreme Court. See Dann, 425 U.S. at 227-29; Graham, 383 U.S. at 35. The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

The PTO may have confused the standard of analogy as it is applied to anticipation with that of obviousness. Applicant directs the PTO's attention to MPEP 2131.05 addressing the issue

of analogy and anticipation. As previously argued, the present case is a 103 rejection and the combined cited art suggests a toy doll, not the claimed invention.

Applicant respectfully contends that the combined cited art does not teach or suggest that which is claimed in the newly amended claims. As stated by the PTO "**both** Asker and Hill references which were relied on as a basis for rejection of an applicant's invention are non-analogous to claimed inventions". Applicant agrees with the PTO's statement that both the *Asker* and *Hill* references are non-analogous. Only the *Asker* and *Hill* references were combined by the PTO to render the independent claims 1 and 16 obvious. The present invention cannot be rendered obvious by the application of non-analogous art. Thus, by operation of law the claims of the present application are allowable over the combined cited art.

### CONCLUSION

Applicant respectfully contends claims 1- 3, 7-11, 13-16, and 19-23 are allowable and an early notice of such effect is earnestly solicited. Should the Examiner have any questions or comments regarding the foregoing Response, she is invited and urged to telephone the undersigned attorney.

Respectfully Submitted,

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